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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/966,230

09/28/2001

Charles W. Shattuck

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(4132-TC-AU)

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MICHAEL BEST & FRIEDRICH LLP
3773 CORPORATE PARKWAY
SUITE 360
CENTER VALLEY, PA 18034-8217

EXAMINER

HANSEN, COLBY M

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,230

Applicant(s)

SHATTUCK ET AL.

Examiner

Colby Hansen

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Condon, Jr. et al. (US Pat. 3,930,692).

Condon, Jr. et al. (US Pat. 3,930,692) discloses a thrust bearing with needle rollers 36, the thrust bearing comprising: a first race component 32 made of a first material and including a flat, circular raceway portion, defined about an axis, and an axially extending lip portion; a plurality of needle rollers 36 arranged radially with respect to the axis for rolling contact with the flat raceway portion of the first race component; a bearing cage 34 retaining the needle rollers 36 and engageable with the lip portion of the first component (figs. 3 & 4) for piloting of the bearing cage 34; and a second race component 22 made of a second material and including a flat portion in contact with the raceway portion of the first race component and, also, including a lip portion 44,50 extending axially and radially from the flat portion and beyond the lip portion of the first race component such that the second race component 22 is engageable by the bearing cage 34 to hold the first race component 32, the second race component 22 and the bearing cage 34 together as an assembly; wherein the axially extending lip portion of the first race component 32 is radially outward of the raceway portion of the first race component 32; wherein the axially extending lip portion of the first race component is radially inward of the raceway portion of the first race component; further comprising an additional thrust race including a circular raceway portion for rolling contact with the rollers 36, the rollers 36 being positioned between the circular raceway portions of the first race component 32 and the

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additional thrust race; wherein the additional thrust race comprises two components 12, 46, 48 made of different materials (as broadly recited, the aforementioned limitation is interpreted as the two components are different parts, occupy different space, thus they utilize different materials from one another); wherein the additional thrust race is engageable by the bearing cage to retain the additional thrust race 46 and the bearing cage 34 together as an assembly wherein the second race component 22 is staked 40,44, at a plurality of locations along a circumference of the lip portion of the second race component (fig. 1), over the lip of the first race component, such that the first race component 32, the second race component 22 and the bearing cage 34 are retained together as an assembly; wherein the second race component 22 includes an extension portion 17,20,26 extending axially from the flat portion of the second race component 22 and in a direction away from the rollers; wherein the first and second race components are formed from sheet metal, the first and second materials being different from each other (as broadly recited, the aforementioned limitation is interpreted as the two components being different, autonomous parts, thus they utilize different materials).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Condon, Jr. et al. (US Pat. 3,930,692).

Condon, Jr. et al. (US Pat. 3,930,692) discloses the claimed invention except for the first and second race components being made of specific material having certain characteristic with respect to one another.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized high carbon, bearing quality steel for the first race component, and more ductile and easily welded low carbon steel for the second race component, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

Applicant's arguments, filed 08/06/2004, with respect to the rejection(s) of claim(s) 1-12 under 35 USC 112, 1st paragraph, 35 USC 112, 2nd paragraph, and 35 USC 102 (b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Condon, Jr. et al. (US Pat. 3,930,692).

Furthermore, Examiner finds applicant's arguments with regard to the drawing objection persuasive and hereby removes the drawing objection of the previous Office Action.

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FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9306**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MEP. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MEP. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MEP. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colby Hansen whose telephone number is (703) 305-1036. The examiner can normally be reached on Monday through Thursday and every other Friday from 7:30 PM to 5:00 PM (EST).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. Any inquiry of a general nature or

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relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Colby M. Hansen

Patent Examiner



11/29/04



Thomas R. Hannon
Primary Examiner